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AS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/511,073 02/23/00 MONDET

J WPB 29683C

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IM22/0305

EXAMINER

SERGEANT, R	PAPER NUMBER
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1711
DATE MAILED:

03/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/511,073

Applicant(s)

Mondet et al.

Examiner

Rabon Sergeant

Group Art Unit
1711



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 13-19 is/are pending in the application.

Of the above, claim(s) 16-18 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 13-15 and 19 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☒ received in Application No. (Series Code/Serial Number) 08/283,765.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 13-15 and 19, drawn to an aqueous dispersion, classified in class 524, subclass 591.
 - II. Claims 16-18, drawn to a cosmetic composition, classified in class 424, subclass 401.

2. The inventions are distinct, each from the other because:

Inventions of Group I and Group II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a component of an aqueous adhesive composition and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. During a telephone conversation with Mr. Christopher Brown on December 15, 2000, a provisional election was made with traverse to prosecute the invention of Group I, claims 13-15 and 19. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 13-15 and 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,538,717. Although

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the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims encompasses an aqueous dispersion of an anionic polyester polyurethane.

8. Claims 13-15 and 19 are directed to an invention not patentably distinct from claims 1-16 of commonly assigned U.S. 5,538,717. The inventions are not considered to be patentably distinct for the same reason given above.

9. Commonly assigned U.S. 5,538,717, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CAR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g).

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CAR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 13-15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over . Fujii et al. ('881).

Fujii et al. disclose aqueous thermoplastic urethane dispersions produced from diisocyanates, such as dicyclohexylmethane diisocyanate; polyester diols; a low molecular weight polyhydroxyl compound; and a dimethylolalkanoic acid. See abstract; column 4, lines 33+; and column 5.

12. Though patentee discloses applicants' claimed polyester diol, patentee does so by way of specifying different diol and diacid reactants, some of which would have yielded polyesters outside the scope of those specified by the applicants; however, the position is taken that the reference teaches to one of ordinary skill that the use of the disclosed polyesters within the specified polyurethane formulations yield polyester polyurethanes suitable for water dispersible applications. Therefore, in the absence of a showing of criticalness attributable to the claimed

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polyester component, the position is taken that it would have been obvious to one of ordinary skill in the art, seeking dispersible urethanes, to select the disclosed reaction constituents from the teachings of the patentee, so as to arrive at the instant invention.

13. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russiello ('308).


Patentee discloses an aqueous coating composition comprising polyurethane particles wherein the polyurethane is produced by reacting diisocyanate with difunctional compounds having sterically hindered acid groups, such as dimethylolpropionic acid; trifunctional compounds; and difunctional compounds, such as diamines and polyesters diols, wherein the polyester diols are disclosed as being the reaction products of diols, such as 2,2-dimethyl-1,3-propane diol, and diacids, such as sebacic acid and terephthalic acid. See abstract; column 3, lines 19+; column 4; and column 5, lines 1-50.

14. Though patentee discloses applicants' claimed polyester polyol, patentee does so by way of specifying several different diol and diacid reactants, some of which would have yielded polyesters outside the scope of those specified by the applicants; however, the position is taken that the reference teaches to one of ordinary skill that the use of the disclosed polyesters within the specified polyurethane formulations yield polyester polyurethanes suitable for water dispersible applications. Therefore, in the absence of a showing of unexpected results attributable to applicants' claimed reactants, the position is taken that it would have been obvious

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to one of ordinary skill in the art, seeking dispersible polyurethanes, to select the disclosed reaction constituents from the teachings of the patentee, so as to arrive at the instant invention.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.


RABON SERGENT
PRIMARY EXAMINER

R. Sergent

February 9, 2001